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DEC 11 2007

**OFFICE OF PETITIONS**

In re Application of	:
Roger P. Jackson	:
Application No. 10/649,412	: DECISION ON PETITION
Filing Date: 08/27/2003	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 10,321	:

This is a decision on the Request for Reconsideration of Petition for Modification of Claim of Priority, filed November 5, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed Amendment. The petition is properly treated as a petition under 37 CFR 1.78(a)(3)

The petition is **DISMISSED**.

Background

Applicant filed a petition to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to prior-filed nonprovisional Application Nos. 09/729,600, filed December 4, 2000, which issued as U.S. Patent No. 6,440,170 on August 27, 2002, and 09/644,722, filed August 23, 2000, which issued as U.S. Patent No. 6,666,888 on December 23, 2003, said claim was set forth in an Application Data Sheet ("ADS").

The petition was dismissed in a Decision mailed December 8, 2006. The Decision dismissing the petition informed Applicant that 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain... the relationship between the applications [to wit] - whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application.

The Decision also informed Applicant that copendency does not exist between the above-identified application, and Application No. 09/729,600, for which the benefit is sought, because Application No. 09/729,600, filed December 4, 2000, issued as U.S. Patent No. 6,440,170 on August 27, 2002, which is one (1) year before the above-identified application was filed.

The January 18, 2007 renewed petition

Applicant filed a renewed petition on January 18, 2007, and included an Amendment that had been corrected to properly state the relationship of the applications, however, similar to the ADS filed with the June 6, 2005 petition, the amendment was still not acceptable as drafted since copendency does not exist between the above-identified application, and Application No. 09/729,600, for which the benefit was sought. Application No. 09/729,600, filed December 4, 2000, issued as U.S. Patent No. 6,440,170 on August 27, 2002, which is one (1) year before the above-identified application was filed. The above-identified application was filed on August 27, 2003. The statute at 35 U.S.C. § 120 permits a continuing application to claim the benefit of the filing date of a copending, previously filed, parent application provided there is inventorship overlap between the continuing application and the parent application. With this petition, the application for which the benefit is sought, 09/729,600, issued as a patent one year before the above-identified application was filed. As such, there is no copendency between the applications.

The petition was dismissed in a Decision mailed March 19, 2007. Applicant was informed that, before the petition under 37 CFR § 1.78(a)(3) could be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters was required. Applicant was also reminded that, if an amendment to the specification, or an application data sheet (ADS), is submitted in an application under final rejection, the amendment or ADS must be in compliance with 37 CFR 1.116. The amendment or ADS filed in an application under final rejection will not be entered as a matter of right. See MPEP 714.12 and 714.13. Therefore, applicants should consider filing a request for continued examination (RCE) (including fee and submission) under 37 CFR 1.114 with the petition to accept an unintentionally delayed benefit claim, the surcharge, and an amendment that adds the proper reference to the first sentence of the specification or an ADS.

The present renewed petition

Applicant files the present renewed petition and asserts that the previous claim of benefit of priority under 35 U.S.C. 120 was in error.. Applicant petitions for the benefit of corrected priority from U.S. Serial Number 09/644,722, now U.S. Patent No. 6,666,888. Applicant includes an amendment to the specification.

Applicable Law, Rules and MPEP

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference to add the above-noted, prior-filed applications in the first sentence of the specification on page one following the title is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

If reconsideration of this decision is desired, a renewed petition under 37 CFR § 1.78(a)(3) and an Application Data Sheet or an amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop PETITIONS  
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                              Alexandria, VA 22313-1450

By hand:                 Customer Service Window  
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                              401 Dulany Street  
                              Alexandria, VA 22314

By fax:                   (571) 273-8300  
                              ATTN: Office of Petitions

Any questions concerning this matter may be directed to attorney Derek Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight  
Supervisor  
Office of Petitions



*Renewed petition  
and Amended spec*

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION FOR MODIFICATION OF CLAIM OF PRIORITY

Applicant: Roger P. Jackson

Serial No.: 10/649,412

Date: October 31, 2007

Filed: August 27, 2003

Group Art Unit: 3733

Exam: Richard R. Shaffer

For: THREADED DEVICE FOR IMPLANTATION BETWEEN VERTEBRAE

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Kansas City, Missouri

Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

It has been determined that the previous claim of benefit of priority under 35 U.S.C. 120 was in error.

Applicant hereby petitions for the benefit of the corrected priority from U.S. Serial No. 09/644,722, now Patent No. 6,666,888, as an unintentionally delayed benefit claim under 35 U.S.C. 119(e).

It is believed that all requirements of the Petition under Rule 78(a)(3) are met as follows:

- a) An amendment to the application to cross reference corrected priority is submitted herewith along with a corrected Data Sheet.

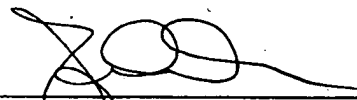
11/06/2007 AAKHADI 00000072 10649412

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1410.00 OP

- b) The surcharge of \$1410 set forth in Rule 17(t) is submitted herewith. If an additional fee must be charged, please charge it to Deposit Account No. 50-1253.
- c) The entire delay between the date when the claim was due and the present was unintentional.

Respectfully Submitted,



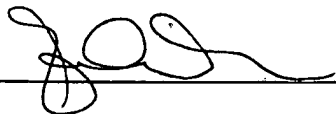
John C. McMahon  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
Mail Stop RCE  
Commissioner For Patents,  
P.O. Box 1450,  
Alexandria, VA 22313-1450 on  
October 31, 2007.

Roger P. Jackson  
(Applicant)

By



October 31, 2007

(Date of Signature)

Roger P. Jackson

Serial No. 10/649,412

IN THE SPECIFICATION:

*Filed w/ Renewed Ref'n*

Please amend the Cross Reference to Related Application  
section of the specification to read as follows:

Cross Reference to related application

The present application is a continuation-in-part of  
application Serial No. ~~09/729,600~~, filed ~~December 4, 2003~~, now  
~~Patent No. 6,444,170~~ 09/644,722, filed August 23, 2000, now  
Patent NO. 6,666,888, which is incorporated herein by reference.

*MA*

Spec filed w/ Application

Express Mail EV196864140US

PATENT

THREADED DEVICE FOR IMPLANTATION BETWEEN VERTEBRAE

Background of the Invention

1           The present application is directed to a threaded  
2   interbody device for implantation between a pair of  
3   adjacent vertebrae in order to provide support to the  
4   vertebrae and/or promote fusion between the vertebrae.

5           In the human spine the pad or disc between vertebrae is  
6   sometimes damaged or deteriorates due to age, disease,  
7   injury or congenital defect. The vertebrae themselves may  
8   also become compressed or otherwise damaged. Because of  
9   this, surgery is often utilized to place spacers or  
10   interbody devices between the vertebrae which provide proper  
11   spacing of the vertebrae and which often are also utilized  
12   to promote fusion between the vertebrae. When a device of  
13   this type is utilized for purposes of promoting fusion, it  
14   is often referred to as a fusion cage or an intervertebral  
15   fusion device. When utilized to promote fusion, the  
16   interbody devices often are windowed and packed with bone so  
17   as to promote growth of the bone between the vertebrae.  
18   Sometimes bone is packed between a pair of devices that are  
19   placed in close proximity to one another between the



ADS Filed w/ Application

Express Mail EV196864140US

APPLICATION DATA SHEET

Applicants - Inventors

- 1) First Inventor: Roger P. Jackson  
4706 W. 86th Street  
Prairie Village, Kansas 66207

Citizenship: United States of America

- 2) Correspondence Address:

John C. McMahon  
PO Box 30069  
Kansas City, MO 64112

- 3) Title of Invention: THREADED DEVICE FOR IMPLANTATION BETWEEN  
VERTEBRAE

Suggested Classification: Class \_\_\_\_\_ Subclass \_\_\_\_\_  
Technology Center \_\_\_\_\_  
Total Number of Drawing Sheets 2  
Docket No. 10,321  
Type of Application: Utility

- 4) Attorney: John C. McMahon  
Address: PO Box 30069  
Kansas City, MO 64112  
Telephone: (816) 531-3470

Attorney Reg. No. 29,415

- 5) Domestic Priority:  
Serial No. 09/644,722; Filed August 23, 2000

- 6) Foreign Priority:

None

- 7) Assignee:

None

*not a proper  
claim*

*But, this is  
the application that  
he wants priority  
to as identified  
in the latest  
petition and  
amendment.*

## Application Number Information

Application Number: **10/649412** [Assignments](#)

Filing or 371(c) Date: **08/27/2003** [eDan](#)

Effective Date: **08/27/2003**

Application Received: **08/28/2003**

Pat. Num./Pub. Num: **/20050049587**

Issue Date: **00/00/0000**

Date of Abandonment: **00/00/0000**

Attorney Docket Number: **10,321**

Status: **60 /FINAL REJECTION COUNTED, NOT YET MAILED**

Confirmation Number: **5307**

Title of Invention: **THREADED DEVICE FOR IMPLANTATION BETWEEN VERTEBRAE**

Examiner Number: **81245 / SHAFFER, RICHARD**

Group Art Unit: **3733**

[IFW Madras](#)

Class/Subclass: **606/061.000**

Lost Case: **NO**

Interference Number:

Unmatched Petition: **NO**

[L&R Code](#): [Secrecy Code](#):1

Third Level Review: **NO**

Secrecy Order: **NO**

Status Date: **11/19/2007**

Oral Hearing: **NO**

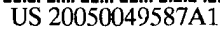
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Appln Info	Contents	Petition Info	Atty/Agent Info	Continuity/Reexam	Foreign Data	Inventors	Ad
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PCT /  /   or PG PUBS #    
Attorney Docket #    
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(12) **Patent Application Publication** (10) Pub. No.: US 2005/0049587 A1  
Jackson (43) Pub. Date: Mar. 3, 2005

(52) U.S. Cl. .... 606/61

(57) **ABSTRACT**

An interbody device having upper and lower surfaces that are sized and shaped to be operably positioned between a pair of adjacent vertebrae for support and/or fusion. The upper and lower surfaces have a generally convex curvature. The upper and lower surfaces are joined by a pair of side surfaces that are arcuate and semi-circular, when viewed from the front, so as to be generally concave. The interbody devices are used in pairs between two vertebrae and joined by a bar that is received in a recess in each of the devices so as to resist rotation of the devices relative to the bar subsequent to installation.

### Publication Classification

(51) **Int. Cl.<sup>7</sup>** ..... **A61B 17/70**

